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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,134	01/25/2001	Spencer A. Rathus	660-015	8417

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EXAMINER

LE, UYEN CHAU N

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 01/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/769,134

Applicant(s)

RATHUS ET AL. 

Examiner

Uyen-Chau N. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 September 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 168-261 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 168-261 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____.                                   |

## DETAILED ACTION

### *Prelim. Amdt/Amendment*

1. Receipt is acknowledged of the Amendment filed 25 September 2002.

### *Obviousness-Type Double Patenting*

2. Claims 168, 256 and 259 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,932,863 (hereinafter '863).

Although the conflicting claims are not identical, they are not patentably distinct from each other because in claims 168, 301 and 304 of the instant application, Applicants claim a system for **displaying programming** material to a user, the system comprising "a **printed advertisement** having at least one **machine recognizable feature**", "a **feature recognition unit** having associated therewith a **means for recognizing** said machine recognizable feature and a **means for transmitting** a **coded signal** in response to the recognition of said machine recognizable feature", "an **intelligent controller** having associated therewith a **means for accessing** said programming material in response to receiving said coded signal", ... and "a **display unit** for presenting said programming material". The '863 patent discloses a system for **displaying programming** to a user, the system comprising, among other things, "a **printed stationery** having at least one **machine recognizable feature**", "a **feature recognition unit** having associated therewith a **means for recognizing** said feature and a **transmitter** a **coded signal** in response to the recognition of said feature", "an **intelligent controller** having

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associated therewith **a means for accessing** said programming material”, ... and “**a display unit** for presenting said programming material”. Although the scope of claims 168, 301 and 304 of the present application and claim 1 of ‘863 patent are almost identical, the difference between the present claimed invention and the ‘863 patent is that the present claimed invention is a broader recitation of the ‘863 patent (e.g., the present claimed invention recites “**a display unit** for presenting said programming material, etc.” whereby the ‘863 patent recites “**a display unit** for presenting said programming material, ... wherein said display unit comprises a personal computer, etc.”). Thus, with respect to above discussions, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to use the teaching of claim 1 of ‘863 patent as a general teaching for having a system for **displaying programming** to a user with the same functions as claimed by the present application. The instant claims obviously encompass the patented claims and differ only in terminology. To the extent that the instant claim is broaden and therefore generic to the patented claims [species], *In re Goodman* 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been patented.

The obviousness-type double patenting rejection is a judicially established doctrine base upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R § 1.78(d).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 168-173, 176-178, 195-196, 198, 212, 220, 227-230, 235-237, 240, 251, 256 and 258-261 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall et al (US 4,488,035) in view of Fields (US 4,481,412) and Tannehill et al (US 5,158,310).

Re claims 168-173, 176-178, 195-196, 198, 212, 220, 227-230, 235-237, 240, 251, 256 and 258-261: Withnall et al discloses a system for displaying information to a user comprising a printed travel ticket (e.g., train, bus, etc.) having at least one machine recognizable feature (i.e., barcode); a feature recognition unit 18 having associated therewith a means for recognizing the machine recognizable feature (col. 4, lines 2-30); display the information on the portable handset illuminated display having a microprocessor with programmable memories (col. 5, lines 10-17).

Withnall et al fails to teach or fairly suggest that the displayed information is programming material and the system further comprising means for transmitting a coded signal in response to the recognition of the machine recognizable feature and an intelligent controller having associated therewith a means for accessing the programming material in response to receiving the coded signal.

Fields teaches the above limitation with an accessing means 10 having a microcontroller 23 including a barcode electronic circuit 25 electrically coupled to the barcode reader 24 for transmitting/accessing the programming material in response to receiving the coded signal (fig. 2; col. 7, line 40 through col. 8, line 11); wherein the displayed data is a video/image/programming/sound/pictorial/electronic/media data and wherein the display 22 is a television/workbook (col. 6, lines 56-64 and col. 8, line 12 through col. 9, line 55).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Fields into the teachings of Withnall et al in order to provide Withnall et al with a higher technology system wherein the user being provided with a full complete information in a flexible ways (i.e., video, pictorial, etc.). Furthermore, such modification would have been an obvious extension as taught by Withnall et al, and therefore an obvious expedient.

Withnall et al as modified by Fields have been discussed above but fails to teach or fairly suggest that the system comprises a printed advertisement and at least one machine recognizable feature comprises a magnetic code/strip.

Tannehill et al teaches the above limitation with printed advertisement (figs. 2, 8-9, 11a & 12) and the machine recognizable feature can be a barcode or a magnetic strip (col. 18, lines 7-12).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Tannehill et al into the teachings of Withnall et al/Fields in order to provide the consumer a convenient way of saving money by displaying an advertising program, which attracting people to shop; business retailers therefore appreciated it because they sell more, thus providing a more user-friendly system. Furthermore, such modification would provide Withnall et al/Fields with an alternative feature for encoding data (i.e., barcode or magnetic strip). Accordingly, such modification would have mere been a substitution of equivalents well within the ordinary skill in the art, and therefore an obvious expedient.

6. Claims 174, 175, 180, 181, 183, 185, 189, 190, 192, 193 and 214-219 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall et al as modified by Fields and Tannehill et al as applied to claim 168 and 301 above, and further in view of Roberts (US 5,324,922) and Malec et al (US 5,287,266). The teachings of Withnall et al as modified by Fields and Tannehill et al have been discussed above.

Re claims 174, 175, 180, 181, 183, 185, 189, 190, 192, 193 and 214-219: Withnall et al/Fields/Tannehill et al have been discussed above but fails to teach or fairly suggest feature for online/home shopping and the data link comprises a cable television line.

Roberts teaches the above limitation with a home/online shopping system (figs. 1-14; col. 1, lines 58+; col. 7, line 35 through col. 12, line 35).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Roberts into the teachings of Withnall et al/Fields/Tannehill et al with the latest technology for a faster system due to the benefit of cable television transmitting capability. Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields/Tannehill et al to provide the user an alternative way of doing shopping (i.e., shopping online/at home), and therefore an obvious expedient.

Withnall et al/Fields/Tannehill et al as modified by Roberts fails to teach or fairly suggest that the data link comprises an ISDN line.

Malec et al teaches the above limitation with the use of ISDN technology (col. 7, lines 1-12).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Malec et al into the teachings of Withnall et al/Fields/Tannehill et al/Roberts in order to provide Withnall et al/Fields/Tannehill et al/Roberts with the latest technology for a more accurate and faster system due to the benefit of ISDN networking line. Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields/Tannehill et al/Roberts and would have mere been a substitution of equivalents (i.e., to cable television line) well within the ordinary skill in the art, and therefore an obvious expedient.

7. Claims 179, 182, 186-188, 191, 194, 199-201, 203-204, 209-210, 213, 221-226, 234, 239, 241-243, 254 and 257 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall et al as modified by Fields and Tannehill et al as applied to claim 168 and 301 above, and further in



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view of Bravman et al (US 5,401,944). The teachings of Withnall et al as modified by Fields and Tannehill et al have been discussed above.

Re claims 179, 182, 186-188, 191, 194, 199-201, 203-204, 209-210, 213, 221-226, 234, 239, 241-243, 254 and 257: Withnall et al/Fields/Tannehill et al have been discussed above but fails to teach or fairly suggest that the displayed information including specific details related to traveling (e.g., seat location, departure terminal, hotel, restaurant, etc.), wherein the display unit comprising a wireless communication device (e.g., a remote unit).

Bravman et al teaches the above limitation with remote units 15 providing all necessary information related to traveling (i.e., seat assignment; airline/hotel/rental cars reservations, etc.) in col. 4, line 21 through col. 14, line 5 and col. 16, line 14 through col. 18, line 22.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Bravman et al into the teachings of Withnall et al/Fields/Tannehill et al in order to provide Withnall et al/Fields/Tannehill et al with a more flexibility system wherein the system is capable of providing the user all of his/her desired information about the trip/vacation that he/she is about to take, and thus providing a more user-friendly system. Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields/Tannehill et al, and therefore an obvious expedient.

8. Claims 197, 202 and 205 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall et al as modified by Fields and Tannehill et al as applied to claim 168 and 301 above, and further in view of Anmelder (DT 2,452,202 A1). The teachings of Withnall et al as modified by Fields and Tannehill et al have been discussed above.

Re claims 197, 202 and 205, Withnall et al/Fields/Tannehill et al have been discussed above but fails to teach or fairly suggest that at least one machine recognizable feature is invisible.

Anmelder teaches the above limitation with the machine recognizable feature is invisible (see English abstract).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Anmelder into the teachings of Withnall et al/Fields/Tannehill et al in order to provide Withnall et al/Fields/Tannehill et al with a more secure system wherein the data recorded in the machine recognizable feature is invisible to naked eye, thus preventing manipulating by fraudulent user. Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields/Tannehill et al, and therefore an obvious expedient.

9. Claims 206-208 and 211 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall et al as modified by Fields and Tannehill et al as applied to claim 168 and 301 above, and further in view of Schach et al (US 5,397,156) and Anmelder (DT 2,452,202 A1). The teachings of Withnall et al as modified by Fields and Tannehill et al have been discussed above.

Re claims 206-208 and 211, Withnall et al/Fields/Tannehill et al have been discussed above but fails to teach or fairly suggest that at least one machine recognizable feature comprises a watermark.

Schach et al teaches the above limitation with a machine recognizable feature 42 comprises a watermark (see abstract).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Schach et al into the teachings of Withnall et al/Fields/Tannehill et al aesthetic purpose. Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields/Tannehill et al, and therefore an obvious expedient.

Withnall et al/Fields/Tannehill et al as modified by Schach et al fails to teach or fairly suggest that at least one machine recognizable feature comprises an invisible watermark.

Anmelder teaches the above limitation with the machine recognizable feature is invisible (see English abstract).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Anmelder into the teachings of Withnall et al/Fields/Tannehill et al/Schach et al in order to provide Withnall et al/Fields/Tannehill et al/Schach et al with a more secure system wherein the data recorded in the machine recognizable feature is invisible to naked eye, thus preventing manipulating by fraudulent user. Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields/Tannehill et al/Schach et al, and therefore an obvious expedient.

10. Claims 231-233, 238, 239, 244-250, 252, 253, 255 and 256 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall et al as modified by Fields and Tannehill et al as applied to claim 168 and 301 above, and further in view of Morales (US 5,872,589). The teachings of Withnall et al as modified by Fields and Tannehill et al have been discussed above.

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Re claims 231-233, 238, 239, 244-250, 252, 253, 255 and 256: Withnall et al/Fields/Tannehill et al have been discussed above but fails to teach or fairly suggest that the display unit comprises a personal planner/phone/pager.

Morales teaches the above limitation in figs. 2, 5, 8 & 9; col. 3, lines 28 through col. 7, line 12).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Morales into the teachings of Withnall et al/Fields/Tannehill et al in order to provide the user with the flexibility of selecting his/her desired display unit that is fitting his/her needs, thus providing a more user-friendly system. Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields/Tannehill et al, and therefore an obvious expedient.

### ***Response to Arguments***

11. Applicant's arguments with respect to claims 168-306 have been considered but are moot in view of the new ground(s) of rejection.

Newly cited reference to Withnall et al, Fields, Bravman et al, Anmelder, Tannehill et al, Malec et al, Schach et al, Morales and Roberts have been used in the new grounds of rejection to meet the newly submitted priority date of the application.

### ***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 703-306-5588. The examiner can normally be reached on M, W, F, SAT 6:00-11:00 and T, TH 8:30-7:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL G LEE can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

*Uyen-Chau N. Le*

December 30, 2002

A handwritten signature in black ink, appearing to read 'Karl D. Frech', written in a cursive style.

KARL D. FRECH  
PRIMARY EXAMINER